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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,000	11/28/2000	Anthony J. Polverino	MBHB00-450-A	6633

20306 7590 09/23/2002

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EXAMINER
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RAWLINGS, STEPHEN L

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 09/23/2002

78

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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09/724,000

EXAMINER
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ART UNIT	PAPER
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18

DATE MAILED:

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**Commissioner of Patents and Trademarks**

**Advisory Action**

Application No.

09/724,000

Applicant(s)

POLVERINO ET AL.

Examiner

Stephen L. Rawlings, Ph.D.

Art Unit

1642

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 July 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 23 July 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached Note of Explanation.
6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 9,13-16,40-42,46,47 and 57-62.Claim(s) withdrawn from consideration: 1-8,10-12,18-36,43-45 and 48-56.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

### NOTE OF EXPLANATION

1. The notice of appeal filed July 23, 2002 in Paper No. 15 is acknowledged and has been entered.
2. The amendment filed July 23, 2002 in Paper No. 16 is acknowledged; however, the proposed amendment to the claims will not be entered and fails to place this application in condition for allowance.
3. The declaration under 37 CFR § 1.131 is acknowledged; however, the merit of the declaration will not be considered because it is not directed solely to issues that were newly raised by the Examiner in the previous and final office action.
4. The proposed amendment to the claims will not be entered, because if it were, the proposed amendment would raise new issues that would require further consideration and/or search and additionally would raise the issue of new matter. In particular, if the claims were to be amended as has been proposed, claims 14, 15, 57, 58, 61, and 62 would recite the limitation "provided that the polypeptide does not further comprise the amino acid sequence of SEQ ID NO: 22", and accordingly, this application would require further consideration. Accordingly, the proposed amendment is not deemed to place this application in better form for appeal by materially reducing or simplifying the issues for appeal.
5. Applicants' request for reconsideration has been carefully considered, but fails to place this application in condition for allowance.

Applicants' remarks regarding the merit of the proposed amendment will not be addressed, since the amendment has not been entered.

Nevertheless, Applicants' remarks have overcome the rejection of claim 47 under 37 USC § 112, first paragraph for the reasons set forth in section 13 of the previous office action.

With regard to the grounds of rejection of claims 57 and 59-61 under 35 USC § 112, first paragraph for the reasons set forth in section 23 of the previous Office Action, Applicants' reply has obviated the rejection in part, since as Applicants have noted there appears to be proper antecedent basis in the original claims for recitation of the phrase "a region of the nucleotide sequence of SEQ ID NO: 4". However, contrary to Applicants' assertions, the language of claim 2, as originally filed, does not appear to provide clear and proper antecedent basis for recitation of the phrase "a region of the nucleotide sequence of the DNA insert" in the present claims.

With regard to the grounds of rejection of claims 57 and 59-61 under 35 USC § 112, second paragraph for the reasons set forth in section 25 of the previous Office Action, Applicants have contended, "one of ordinary skill in the art would readily understand that the phrase 'a region of the nucleotide sequence' would refer to a fragment or portion of the entire nucleotide sequence of SEQ ID NO: 4 or the DNA insert in ATCC Deposit No. PTA-1755" (page 10, paragraph 2). Applicants' remarks have been carefully considered but have not been found persuasive for the reasons set forth in the previous office action, but additionally Applicants are reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

6. For purposes of appeal, claims 1-16, 18-36, and 40-62 are pending in the application. Claims 1-8, 10-12, 18-36, 43-45, and 48-56 have been withdrawn. Claims 9, 13-16, 40-42, 46, 47, and 57-62 are rejected.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings, Ph.D. whose telephone number is (703) 305-3008. The examiner can normally be reached on Monday-Thursday, alternate Fridays, 8:00AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C. Caputa, Ph.D. can be reached on (703) 308-3995. The fax phone numbers for the organization where this application or proceeding is assigned

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are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Stephen L. Rawlings, Ph.D.  
Examiner  
Art Unit 1642

slr  
September 19, 2002



DONNA WORTMAN  
PRIMARY EXAMINER